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Appn. Number 09/872,914

Appn. Filed 06/01/2001

Applicant pro se Ferdinand Schermel

Title Tilttable Modular Recycle Container System

Examiner Stephen J. Costellano

Art Unit 3727

Appeal Brief originally filed Aug. 23, 2004
response to defect Oct. 17, 2004Assistant Commissioner for Patents
Washington, D.C. 20231

total no. of pages of text 19

REPLY BRIEF

Date April 15, 2005

(8) Evidence Relied Upon

The statement at lines 8-10 of the Grounds of Rejection 1 (as indicated by italics) which is relied upon by the examiner must be read in its context which preceded by to fully understand the reference. Applicant includes lines 4-7 of the Grounds of Rejection 1 to clarify :

Under 35 U.S.C. 113 are "The applicant shall furnish a drawing where necessary for the understanding of the subject matter" . In this case not even the original Fig. 1 or the provisional patent drawing or the amended Fig 1 drawings (appendix 2) are necessary for someone skilled in the art to understand and reproduce the invention from the written portion of the disclosure, but with *the original drawings combined with the written disclosure, the various configurations are obvious and simply duplication and in any way adds new matter or additional features that was not part of the original disclosure.*

The applicant in this statement is arguing that the alleged new matter of the second attachable container is an obvious variation of the original disclosure when the original figure with a wheeled container with one attachable container combined with the original claim 2:

"2. The system of claim 1 further including a plurality of attachable containers stacked and secured on top of said attachable container."
and would be apparent to someone skilled in the art.

The examiner relies upon evidence:

Lines 7 and 8 of page 16 of the brief filed November 18, 2004 "Both Tiramani's and the luggage industry have devices having the same base perimeter dimensions of approximately 170 inches."

This should read **170 square inches** and not inches. The applicant apologizes for this typographic error.

Applicant sites Page 19 of the appeal brief lines 3 and 4 states:

"- Tiramani teaches a total volume of 22 gallons with the wheeled container and 3 fastened containers, which follows or is similar to the teaching of luggage devices that are stacked. Both Tiramani's and the luggage industry's teaching has resulted in devices having the same base perimeter dimensions of 170 square inches."

The applicant means to convey that the area of the base with respect to the outer perimeter of that base, is 170 square inches and not 170 linear inches about the perimeter. The applicant has never meant to say that some luggage or Tiramani's tool box is 50 inches wide by 35 inches deep to produce a total perimeter dimension of 170 linear inches of perimeter (i.e. $35'' + 50'' + 35'' + 50'' = 170''$). Tiramani's tool box is approximately 17 inches wide and 10 inches deep. Ironically it is the object of the applicants invention to be able to have a wheeled container 50" wide by 35" deep with a height of say 12" so that it would still be light enough to lift when full of say newspaper but tiltable and rolled by the attachment of enough attachable containers to bring the overall height of the stack to a comfortable rolling height.

The examiner relies upon evidence:

Appellant has previously stated that the species contained in this application are not patentably distinct and unpatentable over each other in lines 8-10 of the request for supervisory review filed February 3, 2003 as paper No. 23.

The following is a copy of the review:

Feb. 3 /2003 No. of pages including this one: 4 and 1 page of drawing

Re: Applicant requests supervisory review of examiner's position of the applicants filing of the RCE not being proper.

Sir:

The applicant respectfully requests a supervisory review as applicant and examiner have been unable to proceed further. Applicant has presented clear and specific arguments but has not received specific responses and, in some instances, any response to arguments. The applicant realizes his limited understanding of the process and rules and reluctantly asks again for supervisory review of the examiner's response and position, as an appropriate next step.

The applicant has outlined how MPEP 806.04 (f, h, e.), and has also added (b) in this paper, prove that the claims of the RCE pertain to the elected invention. Applicant has submitted detailed arguments of how the tests of the MPEP rules support that : claims 1 and 2 are not mutually exclusive, that they are not patentably distinct and unpatentable over each other, that there is no distinction between species, and the claims have a commonality of operation, function and effect. These prove that the restriction

requirement cannot be sustained and that the claims submitted are the elected invention, making the RCE fully responsive and proper.

Since the examiner will not respond to the arguments of how the claims are supported by all of the MPEP rules, rendering proof that there is no distinction of "another specie", but insists that they are directed to "another specie", the applicant respectfully requests that the examiner or supervisor defines the other species in reference to the claims and MPEP rules.

Since the examiner remains unconvinced that the language "at least one attachable container" does not include two nor a plurality of attachable containers, nor responds to the question of this language, applicant respectfully requests that the supervisor would either convince the examiner that at least one includes two, or if in agreement with the examiner, provide an explanation why it does not.

Applicant also requests reference to the MPEP rule or other rule that would not allow the claimed priority to the provisional patent, which shows a wheeled container with two attachable containers (PET page 5 of 5), to support and demonstrate reduction to practice of the configuration in question, as well as not being new matter.

The applicant in this reply brief will also include the original claims:

1. A modular wheeled container system that is tilted from the free standing position for rolling comprising:
 - a) a wheeled container having a means for rolling
 - b) at least one attachable container, and
 - c) a means for securing adjoining said wheeled container to said attachable container.
2. The system of claim 1 further including a plurality of attachable containers stacked and secured on top of said attachable container.

The applicant in this reply brief will also include the PETITION UNDER CFR 1.181 sent Jan 31/2003:

Applicant would respectfully add to the omission or correction submitted November 23, 2002, the following considerations to support that claim 2 is part of the elected invention:

With regards to MPEP 806.04(f). "Claims restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that when one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species". In this patent "at least one attachable container" includes "a plurality of attachable containers" and therefore claims 1 and 2 are not mutually exclusive and cannot be restricted to different species.

With regards to MPEP 806.04(h) the species must be patentably distinct from each other. Restriction should not be required if the species claimed are considered clearly

unpatentable over each other. The forming of a rigid entity is the issue pertaining to the elected species. Suppose a configuration of a wheeled container having two attachable containers as claimed in claim 1 ("at least one attachable container", but in this instance two attachable containers). Such a configuration would be identical to the configuration described or claimed by claim 2 where in this instant case a plurality of two attachable containers is selected. Both claim 1 and 2 in this instance would be clearly unpatentable over each other.

With regards to MPEP 806.04(e) claim 1 and 2 have a commonality of operation, function and effect in that they both form the rigid entity and are both secured in the same manner.

With regards to MPEP 806.04(b) for "at least one attached container" and "a plurality of attached containers" (secured to said wheeled container) are not independent and in order to sustain a restriction requirement, distinction must be shown. Distinction is proven if it can be shown that the intermediate product is useful other than to make the final product. The wheeled container with at least one attached container secured at their adjoining interface produces the final product of a rigid entity that can be tilted for rolling. Similarly, a wheeled container with a plurality of containers secured at their adjoining interface produces the final product of a rigid entity that can be tilted for rolling. The forming of the rigid entity by securing adjoining containers is the object, function, and final product of the invention. The examiner has not given an example of an alternate use to prove distinctness therefore the restriction of claim 2 cannot be sustained if there is no independent species.

The applicant believes that the above context in which the distinction of species is discussed is relevant to understanding that the "not patentably distinct statement and unpatentable over each other" was intended to clarify that the second attachable container is part of the invention and should not be construed as an admission of obviousness of the claim. The subject matter of species is extremely difficult for this pro se inventor in this first patent application to understand. It is still unknown why this statement in the **Evidence Relied Upon** is condemning or accusatory in regards to this application, and an explanation is required in order for the applicant to further argue a defense.

112 Rejections

(9) Grounds of Rejection 3A. (Applicant resubmits pertaining arguments to accommodate the split of 3 into 3A and 3B)

For claims 1, 3-6, 9, 10, 22 and 24-26 regarding the second attachable container as well as the base perimeter greater than 55 as new matter added which was not described in the specification in such a way as to reasonably convey to someone skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claim 3, 4 and 22 pertains to tilted for rolling hitching of single tilted for rolling containers, refuse containers, single rigid entities, or combinations thereof, and are patentably distinct regardless whether or not the rigid entity has one or two attachable

containers on the wheeled container nor the 55 inch base perimeter dimension is supported. Since this rejection has no relevance to these claims the applicant requests that the rejection is withdrawn for these claims.

Claim 5 pertains to a recycle container secured on top of a refuse container that is already at the height for ergonomically comfortable tilting and rolling and appears in the original fig 1 and is patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the 55 inch base perimeter dimension is supported. Since this rejection has no relevance to this claim the applicant requests that the rejection is withdrawn for this claim.

Claim 9 further limits the hitch to remain connected while tilting and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the 55 inch base perimeter dimension is supported. Since this rejection has no relevance to this claim the applicant requests that the rejection is withdrawn for this claim.

Claim 24 is the new use for the Ferbrache handle for securing attachable containers such as a recycle bin to the refuse container, attachable container to each other or to wheeled containers, or as part of a hitch and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the 55 inch base perimeter dimension is supported. Since this rejection has no relevance to this claim the applicant requests that the rejection is withdrawn for this claim.

Claim 25 and 26 pertain to the attachable container which fits specifically on the conventional RUBBERMAID 32 gallon refuse container, instead of a lid, and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the 55 inch base perimeter dimension is supported since only a single attachable container is secured on the 32 gallon RUBBERMAID refuse container is claimed and the base perimeter is that of the 32 gallon RUBBERMAID refuse container. Since this rejection has no relevance to these claims the applicant requests that the rejection is withdrawn for these claims.

Claim 6 specifies the means for securing attachable containers and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the 55 inch base perimeter dimension is supported. Since this rejection has no relevance to this claim the applicant requests that the rejection is withdrawn for this claim.

Since the claims 3-6, 9, 10, 22 and 24-26 are different in function, offer different advantages and unexpected benefits etc., than claim 1, as detailed in the art rejection arguments, and are therefore separately patentable, it is requested that the this rejection is

withdrawn, if the examiner does not agree, then applicant requests details to how the rejection is linked to each of these claims so that arguments can be included in the appeal.

Claim 1. the securing of an attachable container to the RUBBERMAID refuse container is shown in the original Fig 1 and described in the operation as being similar to the lid, which is well know to many people using the refuse container. The securing of the attachable container would not challenge someone skilled in the art to make and use such an attachable container since it entails molding of walls onto the existing lid edge as shown in Fig 3, or simply adding walls to the existing lid. The dimensions are not critical for the walls, and the dimensions and details that do require any significant understanding are already existing, such as the lid edge to RUBBERMAID refuse container opening. Other shapes are shown in Fig 2-8 and dimensions and tolerances are flexible and basic engineering knowledge especially for some skilled in containers or plastics.

The original disclosure under Objects and Advantages page 4 of 13 states, "(k) the wheeled containers will nest in each other and the recycle containers will nest in each other and the wheeled containers will also nest in the recycle containers and the lower size of recycle containers can partially nest in the upper size of recycle container, thus being able to form a single pile of any number of sizes of recycle containers with the wheeled containers reducing shipping costs and distributor shelf space even for small quantities." The original disclosure reads "**the lower size of recycle containers can partially nest in the upper size of recycle container**" clearly states that there are two sizes of recycle container in the one application, described as lower and upper. This proves that the applicant had knowledge and possession and disclosure in the original application supporting the amended fig. 1 showing two recycle containers, a lower and an upper. It is also not possible to construe the recycle container on top of the refuse container as the upper recycle container as it a round not square and definitely too small to allow the lower recycle bin to partially nest in it. Therefore an upper and lower recycle bin are the first and second attachable containers are clearly part of the original specification and not new matter.

For claim 1, applicant has proposed a drawing amendment showing 3 attachable containers on top of a wheeled container. Applicant gives the above explanation as with regards to the second attachable container.

Applicant is presently pursuing the amendment and subsequent rejection of Fig 1 which shows the invention of the rigid entity with two attachable as well as three attachable containers instead of the original simplest or minimal configuration of the invention of the rigid entity with one attachable container (see APPENDIX 2) . Both show the invention of the rigid entity, the amended version is to improve clarity and is shown (reduced to practice) in the provisional patent visually. Applicant still waits for a response from the examiner to the explanation with regards to the art reduced to practice by the provisional patent and the wording of the original claims is not proof that the inventor had possession of the claimed invention regarding the two attachable containers configuration.

Regardless of the rejection or possible allowance of the amended figure, the feature of the invention of the rigid entity is disclosed and the claims, including reference to more

than one attachable container, should be treated as reduced to practice or duplication of the invention or as originally claimed by the limitation "at least one attachable container" as it would be impossible to show every different configuration of attachable container and hitched container. The examiner has requested a proposed drawing correction or corrected drawings. Applicant believes all features of the invention are shown in both figures but is finding it difficult to claim or show the rigid entity novelty.

Under 35 U.S.C. 112 Specification, the second paragraph states "the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. Applicant's specification concludes with claim 1 "at least one attachable container", claim 2 "a plurality of attachable containers stacked and secured on top of said attachable container", and claim 11 "at least one attachable container, and a means for securing adjoining said wheeled container to said attachable container whereby the combined containers form a single rigid entity". These claims are the conclusion of the specification and with the attached drawing of the provisional patent and the original Fig 1 disclose the invention to enable someone skilled in the art to make and use the same. Under 35 U.S.C. 113 are "The applicant shall furnish a drawing where necessary for the understanding of the subject matter" and in this case not even the original Fig. 1 or the provisional patent drawing or the amended Fig 1 drawings are necessary and the amended Fig 1 drawing in any way adds new matter that was not part of the original disclosure.

Applicant has sent with the appeal a drawing of wheeled container with two attachable containers, one attachable container secured to the top of the first attachable container. This drawing is page 6 of 14 of the provisional patent filed on 06/08/2000 application no. 60/209,964 as pursuant to 35 U.S.C. 119(e)(i) priority claimed in the Patent Application Transmittal Letter, and is identical in concept and structure to the amended Fig. 1, showing one wheeled container and two attachable containers. The applicant proposes the amendment to the references of the front page. This drawing of the provisional patent should positively confirm that the art is not new matter to this application and that a wheeled container with two attachable containers stacked on top of the wheeled container is the art reduced to practice as of 06/08/2000. The original fig. 1 illustrated the forming of the rigid entity (also mentioned in claim 11) for rolling in the tilted position showing the simplest configuration of the invention. The forming of the rigid entity is the matter or scope of the claim language in claim 1 and is considered the object of the invention. Claim 11 states "at least one attachable container, and a means for securing adjoining said wheeled container to said attachable container whereby the combined containers form a single rigid entity". Claim 2 adds duplication of the said attachable container and means for securing, and should be considered duplication of existing matter and procedure of claim 1, but not new matter. Claim 2 is primarily relied upon to narrow the attached location of the attachable containers to being on top of the first said attachable container, as well as their structural configuration relative to each other as being stacked (or piled).

Even if claim 2 were considered canceled, the phrase "at least one" in reference to the attachable container of claim 1, clearly claims one as well as two attachable containers, as the amended fig 1 illustrates, or three or a plurality of attachable containers. Claim 1 then

can by itself support the claim language of claim 2 when claim 1 includes more than one attachable container to be attached. Applicant relies on claim 1 language to support the Fig 1 amendment and two attachable containers.

1. A modular wheeled container system that is tilted from the free standing position for rolling comprising:

- a) a wheeled container having a means for rolling
- b) at least one attachable container, and
- c) a means for securing adjoining said wheeled container to said attachable container.

2. The system of claim 1 further including a plurality of attachable containers stacked and secured on top of said attachable container.

The claim 3 issue of hitching is not shown in this Fig 12 and the details of the hitching should not have any bearing on the allowance. This figure would then make it clear for someone skilled in the art to make and use the invention and clarify that the inventor had possession of the claimed invention. The skilled person would see the original Fig 1 with one attachable container and the Fig 12 of a wheeled container with 3 attachable containers clearly stated in the original claim 2 as a plurality of said attachable containers. The first said attachable container is shown in the original fig 1 and the plurality of said attachable containers are stacked and secured on top of said attachable container, simply as duplication of the attachable container already show on the wheeled container. A person skilled in the art reading only the above description of the specification and the original fig 1 should easily be able to use and reproduce the invention having three or more (plurality) attachable containers, if they had broadly interpreted at least one as only one and two or more for the plurality of attachable container as shown in fig 12. Some one skilled in the art would know that by removing one of the three attachable containers, that the inventor must have possessed the claimed invention of two attachable containers as well. Some one skilled in the art broadly interpreting the phrase "at least one" to mean one or only one, would then conclude that "at least one" also included 2 attachable containers, and that the inventor at the time the application was filed knew that two attachable containers was part of the invention and was not later discovered when one of the three attachable container was removed, that a new feature of the invention having only two, and that the claimed invention or a rigid entity for comfortable tilting and rolling was still present. The same person skilled in the art would not be able to patent the configuration with 2 attachable containers.

It is understandable that an inventor cannot keep improving his invention during the patent process without a new date for the improvement being recorded as well as for the practical reasons of examination in terms of additional burden, new issues and new searches. The addition of two or three attachable containers adds no new issues or burdens, and was actually discussed extensively in the Evans art. Applicant is convinced that there is no new matter or patent rule or that the general intent or spirit of the patent law is broken by the amended Fig 1.

The references on the front page to the prior art patents showing three vertically stacked recycle bins, should allow some skilled in the art to conclude that a plurality of stacked recycle bins or attachable containers must be part of the invention and would be most

likely be surprised that the inventor would not have possession of this feature of the invention at the time of filing.

Would someone, skilled in the art, after being shown the original Fig 1 and then told at least one attachable container, as well as being on top of the attachable container as well as a plurality of attachable containers in claim 2, not be able to make or use the invention?

Under 35 U.S.C. 112 applicant has shown by the attached provisional patent drawing and the claim of "at least one attachable container" that at the time the application was filed, had possession of the claimed invention of two attachable containers. How do these two items not prove this?

Under 35 U.S.C. 112 Specification, the second paragraph states "the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. Applicant's specification concludes with claim 1 "at least one attachable container", claim 2 "a plurality of attachable containers stacked and secured on top of said attachable container", and claim 11 "at least one attachable container, and a means for securing adjoining said wheeled container to said attachable container whereby the combined containers form a single rigid entity". These claims are the conclusion of the specification and with the attached drawing of the provisional patent and the original Fig 1 disclose the invention to enable someone skilled in the art to make and use the same. Under U.S.C. 113 are "The applicant shall furnish a drawing where necessary for the understanding of the subject matter" and in this case not even original Fig. 1 or the provisional patent drawing or the amended Fig 1 drawings are necessary and the amended Fig 1 drawing does not in any way add new matter that was not part of the original disclosure. What is the new matter that would add benefit to this invention that applicant has not already disclosed? Why are the drawings even necessary?

In the original specification a RUBBERMAID 32 gallon refuse container is shown. It is well known that the base perimeter of the this container is approximately of 50 linear inches since it is 16 inches in diameter. This is a base area of 201 square inches The applicant's drawing clearly shows the wheeled container significantly larger than the RUBBERMAID refuse container as well as square in shape. Scaling the drawing shows that the base perimeter of the wheeled container relative to the RUBBERMAID 32 gallon refuse container to be 16 inches by 16 inches or a base perimeter of 64 linear inches or base area of 256 square inches. **This clearly shows that the base perimeter greater than 55 inches as recited in claim 1 is supported by the original specification, and is therefore not new matter.** The object and advantages clearly outline the new and unexpected result of increased volume without the effective lifting weight being increased as the containers are dumped independently.

112 Rejections**(9) Grounds of Rejection 3B.**

For claims 1, 3-6, 9, 10, 22 and 24-26 regarding rejection of claims being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, referring to "an optional second attachable container".

Claim 3, 4 and 22 pertains to tilted for rolling hitching of single tilted for rolling containers, refuse containers, single rigid entities, or combinations thereof, and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the claims being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, referring to "an optional second attachable container".

Since this rejection has no relevance to these claims the applicant requests that the rejection is withdrawn for these claims.

Claim 5 pertains to a recycle container secured on top of a refuse container that is already at the height for ergonomically comfortable tilting and rolling and appears in the original fig 1 and is patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the claims being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, referring to "an optional second attachable container". Since this rejection has no relevance to this claim the applicant requests that the rejection is withdrawn for this claim.

Claim 9 further limits the hitch to remain connected while tilting and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the claims being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, referring to "an optional second attachable container. Since this rejection has no relevance to this claim the applicant requests that the rejection is withdrawn for this claim.

Claim 24 is the new use for the Ferbrache handle for securing attachable containers such as a recycle bin to the refuse container, attachable container to each other or to wheeled containers, or as part of a hitch and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the claims being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, referring to "an optional second attachable container". Since this rejection has no relevance to this claim the applicant requests that the rejection is withdrawn for this claim.

Claim 25 and 26 pertain to the attachable container which fits specifically on the conventional RUBBERMAID 32 gallon refuse container, instead of a lid, and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the claims being indefinite for failing to

11

particularly point out and distinctly claim the subject matter which applicant regards as the invention, referring to "an optional second attachable container" since only a single attachable container is secured on the 32 gallon RUBBERMAID refuse container is claimed and the base perimeter is that of the 32 gallon RUBBERMAID refuse container. Since this rejection has no relevance to these claims the applicant requests that the rejection is withdrawn for these claims.

Claim 6 specifies the means for securing attachable containers and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the claims being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, referring to "an optional second attachable container". Since this rejection has no relevance to this claim the applicant requests that the rejection is withdrawn for this claim.

Since the claims 3-6, 9, 10, 22 and 24-26 are different in function, offer different advantages and unexpected benefits etc., than claim 1, as detailed in the art rejection arguments, and are therefore separately patentable, it is requested that the this rejection is withdrawn, if the examiner does not agree, then applicant requests details to how the rejection is linked to each of these claims so that arguments can be included in the appeal.

For claim 1 regarding the claim being indefinite because it contains an optional limitation, an optional second attachable container, and the metes and bounds of the claim; that is the scope of the claim cannot be determined since it can't be determined if the second attachable container is part of the claim or not.

The claim 1 optional limitation states:

" a second attachable container wherein the combined height of the said wheeled container and said attachable container is increased to reach the height necessary for ergonomically comfortable tilting and rolling,"

The main object of the invention is to use attachable containers to bring the height of the wheeled container to an ergonomically comfortable height for rolling while still allowing the base perimeter to exceed the 55 inch perimeter restriction that prevents the wheeled container from becoming too large, hence too heavy to lift and dump. For claim 1, **the option is not an option** if the height of the rigid entity formed by a wheeled container and a first attachable container is not high enough for ergonomically comfortable tilting and rolling. This being the case, the limitation and object of the invention are not met. The condition " to be added if the combined height of the said wheeled container and said first attachable container do not reach the height for ergonomically comfortable tilting and rolling." determines when the second attachable container is part of the claim. This would make the claim definite since the scope of the claim is to form a rigid entity of sufficient height for ergonomically comfortable tilting and rolling. If the height of a single attachable container is sufficient for ergonomically comfortable tilting and rolling, the invention's object and limitation are met. If met, and a second attachable container is added anyway, say for extra segregation of goods, the height would exceed the minimal requirement of

the invention but the invention is still complete and operation in that the ergonomic benefit is realized as defined by the claim. The metes and bounds, or the scope of the claim is thus defined by the metes and bounds of ergonomically comfortable tilting and rolling being met or not. The optional condition is not actually an option but a means by which the invention is realized if the rigid entity is too short for ergonomically comfortable tilting and rolling.

The following definition is included in the specification under Definition of Terms (APPENDIX 4):

ergonomically comfortable tilting and rolling - refers to the height of the rigid entity is sufficient to allow an adult to tilt and then roll the rigid entity with their back or spine in the straightened position.

It is impossible to determine a specific height that would be comfortable for all adults since they vary in height and arm length. This definition does clarify that when the spine of the adult is in the straightened position, a level of comfort is achieved and realized. This then is the determining factor for comfort, which in turn is the determining factor for the minimal height of the rigid entity which in turn determines the number of attachable containers required to reach this height, thus defining the claim 1 condition which is the main feature of the invention. A child size version of a general purpose cart would have a different height but still be definitive if the condition of a straight spine is met.

In the event that the rigid entity formed is taller than necessary for a straight spine, the person still has the option of holding the lower handle of the wheeled container or the first attachable container. This is also true for a very short person or a person with long arms. A person could also roll the rigid entity in the tilted position with their arms elevated from the vertical position and still realize the benefit of the invention of a straight spine.

The RUBBERMAID 32 gallon container base perimeter dimension is inferior in terms of stability but this compromise is essential in terms of comfortable rolling in order to increase the height of the container. The Ferbrache handle further increases the effective gripping height by protruding above the rim, without increasing its volumetric capacity and corresponding lifting weight (base perimeter restriction argument). This container is considered unstable with respect to other refuse containers of similar capacity by collection people, and are known to found on their side rolling in the wind on the roadway. This is due to it being taller with a smaller base as compared with shorter larger base containers for the same capacity of 32 gallons.

Due to applicant's lack of knowledge or resources, the applicant is unable to provide precedents or references of other inventions where the claim is made definite by the *need being realized or met*, as the optional limitation of the claim. It would seem that this is not unusual or that certain wording would make the claim definite without diminishing the broadness of the claim. The applicant requests that the Board of Appeals would consider known precedents that are relevant and apply them to this case.

The applicant for the above reasons appeals claim 1 particularly " a second attachable container wherein the combined height of the said wheeled container and said attachable

container is increased to reach the height necessary for ergonomically comfortable tilting and rolling", as being definite.

Applicant asks for constructive assistance if the Board of Appeals still deems the claim indefinite, and suggests including the definition in the claim such as: *wherein the height of the rigid entity is sufficient to allow an adult to tilt and then roll the rigid entity with their back or spine in the straightened position*. Or perhaps specifying a minimal or precise height for the rigid entity of say 34 inches (same height as the RUBBERMAID container) would meet the requirements of being definite. However this would then allow infringement of a child's general purpose cart.

Perhaps another method of making the claim definitive is to specify say one wheeled container and one attachable container as disclosed by the original figure 1, this however would allow infringement of a three or four shallow attachable container rigid entities. It is hoped that the retail outlet will supply modular components so that a person could select containers to suit their needs and body size.

The limitation "the a base perimeter" in line 26 of claim 1 was corrected in the claims appendix to the appeal by removing "the" and also in the AMENDMENT F of December 26, 2003 as being crossed out.

Grounds of Rejection 4

the applicant relies on the arguments supplied with the appeal brief

Grounds of Rejection 5

the applicant relies on the arguments supplied with the appeal brief

Grounds of Rejection 6

the applicant relies on the arguments supplied with the appeal brief

Grounds of Rejection 7

the applicant relies on the arguments supplied with the appeal brief

(10) RESPONSE to EXAMINERS ARGUMENT**Grounds of Rejection 3A: 112, first paragraph rejection (new matter)**

The statement at lines 8-10 of the Grounds of Rejection 1 (as indicated by italics) which is relied upon by the examiner must be read in its context which preceded by to fully understand the reference. Applicant includes lines 4-7 of the Grounds of Rejection 1 to clarify :

Under 35 U.S.C. 113 are "The applicant shall furnish a drawing where necessary for the understanding of the subject matter" . *In this case not even the original Fig.1 or the provisional patent drawing or the amended Fig. 1 drawings(appendix 2) are necessary for someone skilled in the art to understand and reproduce the invention from the written portion of the disclosure, but with the original drawings combined with the written disclosure, the various configurations are obvious and simply duplication and in any way adds new matter or additional features that was not part of the original disclosure.*

The applicant does not agree with the examiner's comment that:

" This statement concedes that added the provisional patent drawing and amended Fig 1(appendix 2) are new matter."

The applicant in this statement is arguing that the alleged new matter of the second attachable container is an obvious variation of the original disclosure when the original figure with a wheeled container with one attachable container combined with the original claim 2:

"2. The system of claim 1 further including a plurality of attachable containers stacked and secured on top of said attachable container."

and would be apparent to someone skilled in the art even without the provisional patent or the amended Fig 1 and that they are not considered necessary under 35 U.S.C. 113.

The applicant does not state or concede that referring to a provisional patent or a proposed drawing amendment constitute adding new matter.

(10) RESPONSE to EXAMINERS ARGUMENT**Grounds of Rejection 3B: 112, second paragraph rejection**

(applicant repeats argument under 112 Rejections(9) Grounds of Rejection 3B.)

For claim 1 regarding the claim being indefinite because it contains an optional limitation, an optional second attachable container, and the metes and bounds of the claim, that is the scope of the claim cannot be determined since it can't be determined if the second attachable container is part of the claim or not.

The claim 1 optional limitation states:

" a second attachable container wherein the combined height of the said wheeled container and said attachable container is increased to reach the height necessary for ergonomically comfortable tilting and rolling,"

The main object of the invention is to use attachable containers to bring the height of the wheeled container to an ergonomically comfortable height for rolling while still allowing the base perimeter to exceed the 55 inch perimeter restriction that prevents the wheeled container from becoming too large, hence too heavy to lift and dump. For claim 1, **the option is not an option** if the height of the rigid entity formed by a wheeled container and a first attachable container is not high enough for ergonomically comfortable tilting and rolling. This being the case, the limitation and object of the invention are not met. The condition "to be added if the combined height of the said wheeled container and said first attachable container do not reach the height for ergonomically comfortable tilting and rolling." determines when the second attachable container is part of the claim. This would make the claim definite since the scope of the claim is to form a rigid entity of sufficient height for ergonomically comfortable tilting and rolling. If the height of a single attachable container is sufficient for ergonomically comfortable tilting and rolling, the invention's object and limitation are met. If met, and a second attachable container is added anyway, say for extra segregation of goods, the height would exceed the minimal requirement of the invention but the invention is still complete and operation in that the ergonomic benefit is realized as defined by the claim. The metes and bounds, or the scope of the claim is thus defined by the metes and bounds of ergonomically comfortable tilting and rolling being met or not. The optional condition is not actually an option but a means by which the invention is realized if the rigid entity is too short for ergonomically comfortable tilting and rolling.

The following definition is included in the specification under Definition of Terms (APPENDIX 4):

ergonomically comfortable tilting and rolling - refers to the height of the rigid entity is sufficient to allow an adult to tilt and then roll the rigid entity with their back or spine in the straightened position.

It is impossible to determine a specific height that would be comfortable for all adults since they vary in height and arm length. This definition does clarify that when the spine of the adult is in the straightened position, a level of comfort is achieved and realized. This then is the determining factor for comfort, which in turn is the determining factor for the minimal height of the rigid entity which in turn determines the number of attachable containers required to reach this height, thus defining the claim 1 condition which is the main feature of the invention. A child size version of a general purpose cart would have a different height but still be definitive if the condition of a straight spine is met.

In the event that the rigid entity formed is taller than necessary for a straight spine, the person still has the option of holding the lower handle of the wheeled container or the first attachable container. This is also true for a very short person or a person with long arms. A person could also roll the rigid entity in the tilted position with their arms elevated from the vertical position and still realize the benefit of the invention of a straight spine.

The RUBBERMAID 32 gallon container base perimeter dimension is inferior in terms of stability but this compromise is essential in terms of comfortable rolling in order to increase the height of the container. The Ferbrache handle further increases the effective

gripping height by protruding above the rim, without increasing it's volumetric capacity and corresponding lifting weight (base perimeter restriction argument). This container is considered unstable with respect to other refuse containers of similar capacity by collection people, and are known to found on their side rolling in the wind on the roadway. This is due to it being taller with a smaller base as compared with shorter larger base containers for the same capacity of 32 gallons.

Due to applicant's lack of knowledge or resources, the applicant is unable to provide precedents or references of other inventions where the claim is made definite by the *need being realized or met*, as the optional limitation of the claim. It would seem that this is not unusual or that certain wording would make the claim definite without diminishing the broadness of the claim. The applicant requests that the Board of Appeals would consider known precedents that are relevant and apply them to this case.

The applicant for the above reasons appeals claim 1 particularly " a second attachable container wherein the combined height of the said wheeled container and said attachable container is increased to reach the height necessary for ergonomically comfortable tilting and rolling", as being definite.

Applicant asks for constructive assistance if the Board of Appeals still deems the claim indefinite, and suggests including the definition in the claim such as: *wherein the height of the rigid entity is sufficient to allow an adult to tilt and then roll the rigid entity with their back or spine in the straightened position*. Or perhaps specifying a minimal or precise height for the rigid entity of say 34 inches (same height as the RUBBERMAID container) would meet the requirements of being definite. However this would then allow infringement of a child's general purpose cart.

Perhaps another method of making the claim definitive is to specify say one wheeled container and one attachable container as disclosed by the original figure 1, this however would allow infringement of a three or four shallow attachable container rigid entities. It is hoped that the retail outlet will supply modular components so that a person could select containers to suit their needs and body size.

In addition to the above earlier stated argument, the applicant responds to the examiners specific argument:

"that for two people, one person who is relatively short with a high tolerance for discomfort and the other person who is relatively tall with a low tolerance for discomfort, this condition has a very different meaning. The tall person would experience discomfort at almost any height and would prefer the addition of another container. This is indefinite since the invention since the invention would be dependent on the preference."

The applicant does not claim that the invention will eliminate discomfort for the tall person. However the tall person would experience a reduced level of discomfort when the rigid entity meets or exceeds a height where the spine of the tall person remains straight while pulling and rolling. The shorter person will feel the reduced level of discomfort from a shorter rigid entity since their spine remains straight while rolling even with only one

attachable container. The short person would still prefer the second attachable container if they require the extra capacity or segregation of goods and may still grip the handle of the first attachable container. Thus the invention is not dependent on a persons preference but rather their height which requires the addition of a minimal and varying number and sizes of attachable containers to produce or realize the invention, resulting in reduced discomfort from a straight spine or ergonomically comfortable tilting for rolling, hence the claim is definite.

(10) RESPONSE to EXAMINERS ARGUMENT

Grounds of Rejection 4: 103 Rejection of Tiramani 1 and Tiramani 2

The examiner states:

Appellant concedes the "greater than 55 inches" base perimeter limitation on lines 7 and 8 of page 16 of the brief filed November 19, 2004.

Lines 7 and 8 of page 16 of the brief filed November 18, 2004 state:

"Both Tiramani's and the luggage industry have devices having the same base perimeter dimensions of approximately 170 inches."

The applicant repeats the argument from (8) **Evidence Relied Upon**

This should read **170 square inches** and not inches. The applicant apologizes for this typographic error.

Applicant sites Page 19 of the appeal brief lines 3 and 4 states:

"- Tiramani teaches a total volume of 22 gallons with the wheeled container and 3 fastened containers, which follows or is similar to the teaching of luggage devices that are stacked. Both Tiramani's and the luggage industry's teaching has resulted in devices having the same base perimeter dimensions of 170 square inches."

The applicant means to convey that the area of the base with respect to the outer perimeter of that base, is 170 square inches and not 170 linear inches about the perimeter. The applicant has never meant to say that some luggage or Tiramani's tool box is 50 inches wide by 35 inches deep to produce a total perimeter dimension of 170 linear inches of perimeter (i.e. $35'' + 50'' + 35'' + 50'' = 170''$). Tiramani's tool box is approximately 17 inches wide and 10 inches deep. Ironically it is the object of the applicants invention to be able to have a wheeled container 50" wide by 35" deep with a height of say 12" so that it would still be light enough to lift when full of say newspaper but tiltable and rolled by the attachment of enough attachable containers to bring the overall height of the stack to a comfortable rolling height.

The examiner states:

"Appellant hasn't rebutted or seasonally challenged the statement in the rejection that 32 gallon (capacity) trash containers are well known. Further, appellant's specification doesn't specify criticality to a two container rigid entity of greater than 32 gallon. If one of the two containers of the two container rigid has a 32 gallon capacity, the rigid entity will have a total capacity of greater than 32 gallons."

A two container rigid entity is that is greater than 32 gallons is shown in the specification. The main object of the invention is to create a container system of hitched rigid entities to first of all increase the volumetric capacity well above the 32 gallon capacity, without increasing the effective lifting weight. The two container rigid entity where one of the containers is 32 gallons, or greater, would defeat the goal of reducing the effective lifting weight which corresponds with the 32 gallon volume, which is considered at, or above, the comfortable lifting and dumping weight limit for the average person as well as the shape of a long narrow container is more difficult to invert for dumping.

(10) RESPONSE to EXAMINERS ARGUMENT

Grounds of Rejection 5: 103 Rejection of Tiramani 1 and Tiramani 2 in view of Tolbert

applicant includes the arguments submitted with the Appeal Brief of page 23 Grounds of Rejection 5 in response and repeats the specific arguments on page 26 and 27:

In the July/02 conversation, the examiner suggested a limitation of perhaps greater than 10 degrees of tilt to overcome Tolbert with regards to possible tilting that may result from impacting or acceleration of the Tolbert system. It was agreed that it is unreasonable to expect the Tolbert container to balance on the single lead wheel located in line and below the hitch. Even a single Tolbert container would be extremely difficult for a person to hold tilted at any angle, and that with Tolbert's hitching structure it would be impossible to roll a train of tilted containers each on their one single swivel front castor for any distance at even the slightest angle.

It was also agreed that the casters do not function when the plane of swivel of the castor is tilted relative to the plane of the surface of travel (floor). Since tilted hitching is not shown by Tolbert, it is inapplicable in combination with Tiramani, making the combination even more unobvious.

The applicant added the 10 degree tilt limitation to overcome the examiner's argument concerning minimal wheel tilt due to clearances due to free tolerances associated with the free movement of the wheel mechanisms, and the definition of tilting is part of claim 3.

Also from APPENDIX 4; DEFINITION OF TERMS:

tilted for rolling - means that the wheeled container or rigid entity is tilted so that the center of gravity is shifted vertically and held in position above the axis of the means for

rolling in order to vertically balance the container in a coplanar direction perpendicular to the axis of rotation. This is typically in excess of a 10 degree angle (for symmetrical evenly loaded containers) between the vertical axis of the container in its free standing position.

(10) RESPONSE to EXAMINERS ARGUMENT

Grounds of Rejection 5: 103 Rejection of Tiramani 1 and Tiramani 2 in view of Tolbert and further in view of Ferbrache

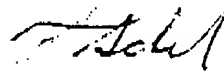
the following is found line 17-20 page 29 of the appeal brief under: 7. **The proposed combination is made inoperative by the Ferbrache handles...**

If the handles for lifting were placed on the forward and behind sides of axle instead of snapping mechanisms at both axle end sides, the containers would have the handles on the long front and rear of the containers instead of the shorter ends making extension of the telescopic handle impossible as it would hit the Ferbrache handles.

The telescopic handle of Teramani (56) slides in a channel in the wheeled container and is extended upward and locked into position to bring the gripping point to a height of 33 inches above the floor so that the tool box can be tilted and rolled with person rolling in an ergonomically comfortable position. The applicant presumes that the Ferbrache handle is not considered here to replace the telescopic handle of Teramani (56), rather only the snapping mechanisms (66) that are construed as handles. The applicant argues that the Ferbrache handles would need to be located on the forward and behind sides of axle, instead of snapping mechanisms 66 located at both axle end sides of the Teramani tool box, in order to facilitate hitching of the Ferbrache handles. The Ferbrache handles would then prevent the telescopic handle of Teramani (56) from being extended upward.

For the above reasons the applicant requests the Board of appeal to allow the claims.

Very respectfully,



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